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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,722	07/31/2008	Ray Henry Everson	A-10208	9397

20741 7590 03/05/2009  
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ARLINGTON, VA 22202-3843

EXAMINER
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ISLAM, SYED A

ART UNIT	PAPER NUMBER
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3611

MAIL DATE	DELIVERY MODE
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03/05/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/594,722	<b>Applicant(s)</b> EVERSON ET AL.	
	<b>Examiner</b> SYED A. ISLAM	<b>Art Unit</b> 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 8 recite the limitation "base portion" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 8, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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2. Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Sachs-Lavery (6,865,836).

3. Regarding claims 1-7, 9 and 10, Sachs-Lavery discloses an ice cave image system **10 (col. 3, line 7; see fig. 1)** including an ice cave panel **12 (col. 3, line 8; see fig. 1)** with an outer opaque portion and a central clear portion, an exchangeable image printed substrate **16 (col. 3, line 12; see fig. 1)** adapted to be retained adjacent the ice cave panel and an image retention system **12A-12D (col. 3, line 46)**, the image retention system including a plurality of retention portions spaced about the central clear portion, each retention portion having magnetic properties **20 (col. 3, line 56)**, and an attachment portion **12A-12D** to attach the retention portion relative to the central clear portion of the ice cave portion and a clamping member **14A-14D (col. 4, line 2; see fig. 1)** having magnetic properties, wherein each retention portion locates to image substrate **16** relative to the central clear portion of the ice cave panel and the image substrate is clamped in position between the retention portion and the clamping member **14**, wherein the retention portions are mounted directly onto the ice cave panel **12E-12G**, wherein the retention portions are mounted to or relative to a housing in which the ice cave display is used, wherein each of the retention portions is manufactured of a metal in order to provide the magnetic properties, wherein the retention portions have an L-shaped configuration having a base attachment portion **20A-20D** and an upstand locating portion **12A-12D**, wherein the base portion of the retention portion has magnetic properties and the upstand portion is magnetically neutral, wherein a clamping member **14A-14D** is provided for each retention member

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between which an edge of an image substrate is clamped, each clamping member being a magnet, wherein the clamping member **14A-14D** is attached to the retention member to which it is paired in order that the clamping member not be lost when removed as a part of the image substrate replacement procedure.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs-Lavery in view of Kane et al. (4,583,309).

6. Regarding claim 8, Sachs-Lavery fails to disclose, the base portion is provided with a fastening means such as an adhesive means in order to securely fasten the retention means relative to the ice cave panel. However, Kane et al. disclose the base portion **26 (col. 5, line 15; see fig. 7)** is provided with a fastening means such as an adhesive means (**col. 5, line 16**) in order to securely fasten the retention means relative to the ice cave panel. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use the teaching of Kane et al. in the invention of Sachs-Lavery for the purpose of reducing the manufacturing cost.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SYED A. ISLAM whose telephone number is (571)272-7768. The examiner can normally be reached on Monday-Friday 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul N. Dickson can be reached on (571) 272-6669. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. A. I./  
Examiner, Art Unit 3611

/Paul N. Dickson/  
Supervisory Patent Examiner, Art Unit 3611